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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,826	09/24/1999	ANNETTE WAGNER	082225.P2813	9950

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EXAMINER
DAVIS, TEMICA M

ART UNIT	PAPER NUMBER
2685	

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/405,826	Wagner et al.
Examiner	**Art Unit**
Temica M. Davis	2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Feb 21, 2002

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 35-49 and 53-56 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 35-49 and 53-56 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Reassignment Affecting Application Location

1. The art unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to art unit 2685.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U. S. C. 103 (a) which forms the basis for all obviousness rejections set forth in this Offce action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in Graham v. John Deere CO., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S. C. 103 (a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U. S. C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U. S. C. 103 (c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 35-49 and 53-56 are rejected under 35 U. S. C. 103 (a) as being unpatentable over Nguyen, U.S. Patent No. 5,797,089 in view of Christal, U.S. Patent No. 5,875,403.

As to claims 35,38,44,47,50,53 and 56, Nguyen discloses a portable telephone (figure 1) containing a transceiver, display and control circuitry configured to enable the portable telephone to send and receive electronic messages using the transceiver and also causes a "graphical user interface" to be displayed in order to allow the user to access stored messages in order to properly transmit and handle the electronic messages (col. 6, line 16 - col. 7, line 29). Nguyen does not specifically disclose the use of automatically entering a reply mode when a message is selected.

However, such a "machine-implemented" technique is shown by Christal in which an appropriate reply, or return, message is created when a message is selected (figure 4 and its description). Therefore, it would have been obvious to one having ordinary skill in the art to apply this "automatic" reply mode technique of Christal to the system of Nguyen for the simple purpose of present the reply message in an easy and prompt manner. It is considered that the above modified system contains a transceiver that receives both voice and non-voice information, which can be updated, and outputs such non-voice information to a display as recited in claims 50,53 and 56. As to claims 36-37,39-43, 45-46,48-49,51-52 and 54-55, also disclosed by Christal is the automatic entering of an appropriate "reply mode" when a user selects a particular message to be sent. It is considered that the messages of Greco contains the source of each message in order for the reply modes to operate properly. It may also be considered that since a voice message has been selected, the device is automatically placed in a voice message transmission mode, a particular reply mode, in order to properly and automatically transmit such a message.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Tan Ornum, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 35-49 and 53-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,169,911. Although the conflicting claims are not identical, they are not patentably distinct from each other because the added feature of the automatic reply technique specifically being machine implemented does not render the above claims patentably distinct from claims 1-14 of Patent No. 6,169,911.

Response to Arguments

7. Applicant's arguments filed February 21, 2002 have been fully considered but they are not persuasive.

Applicant argues that the combination of Nguyen or Christal fails to disclose automatically selecting a form for a message to be transmitted based on the content of the displayed information since both require the user to manually create response.

The examiner, however, disagrees. Christal discloses wherein a reply message (return message) can be created and sent to the sender of the original message. Christal shows wherein a first message can be displayed, and wherein a next message can be displayed (figure 4). The message to which a reply will be sent is not selected until the user presses edit. The pressing of the edit button, hence selects the message. As further shown in figure 4, after the desired message is selected, the user is now automatically able to create a return message (reply). Further, if the user does not which to create a return message with the keyboard, at the end of an incoming message is received, the phone automatically enters a reply mode which allows the user to reply with a YES response wherein the YES reply is sent back to the sender of the original message (figure 4).

Regarding the double patenting rejection, the applicant also argues that Wagner does not teach or suggest automatically entering a reply mode in response to detecting predetermined content.

The examiner, however, disagrees. In the independent claims, Wagner teaches entering an automatic reply mode such as as an e-mail reply mode or avoice reply mode based on a source identifier in the received message.

Based on the remarks above, the claims stand rejected.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday from 7:30 am to 5:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Edward Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2600 Customer Service whose telephone number is (703)306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for any communications intended for entry).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Temica M. Davis
May 5, 2002

EDWARD F. URBAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600